

## REMARKS

Claims 9-12 remain pending in this application. Claims 5-8 were canceled, without prejudice and replaced with new claims 9-12. No new matter has been introduced as a result of the amendments. Support for the amendments may be found in the specification on page 2, lines 7-20 and page 4, lines 4-26. Favorable reconsideration is respectfully requested.

Previous claims 5-8 were rejected under 35 U.S.C §103(a) as being unpatentable over Morgenthaler (US Patent 6,310,609) in view of Overy et al. (US 6,363,264). Applicants traverse this rejection.

Specifically, the cited art, alone or in combination, fails to teach the features of “a memory table in the microprocessor, the memory table including catch-words with each catch-word having a respective option function allocated thereto; and an input device that accepts input from a user of the telecommunication terminal to select an option function without changing operating modes in the process, wherein, when a catch-word is selected by the user via the input device, a respective option function allocated to the catch-word is immediately implemented after the selected catch-word has been confirmed” as recited in claim 9.

Regarding Morgenthaler, the Office Action concedes these features are not disclosed in the document. Regarding Overy, the document discloses telephone that returns to a selectable default mode when idle and has programmable keys with associated functions that depend upon the default mode of the radio telephone. Overy teaches that a radio telephone operates in user selectable default modes to which the radio telephone returns under predetermined conditions wherein a specific key (14, 15) is assigned with an associated legend for indicating the prevailing function associated to the key. The telephone in Overy responds to actuation of the key by performing the respective associated function in the respective default mode (col. 1, lines 51-59; col. 3, lines 26-32). The functions performed in Overy relate to two modes of operation: (1) the NORMAL mode in which the two soft keys (14, 15) perform the functions of selecting the menu and accessing the radio telephone's memories when idle and (2) an EASY OPERATION mode in which in the idle state the two soft keys perform the functions of speed dialing respective numbers selected by the user (col. 4, lines 26-40). Overy further teaches an alternate embodiment (FIGs. 8A-B) where users may define functions for the soft keys over a range of default modes (col. 8, line s 1-7). According to Overy, a user may create a new default mode,

wherein a menu function may be assigned to a specific soft key under the added mode (col. 8, lines 30-55; see also col. 3, line 53 - col. 4, line 8). However,

Thus, Overy fails to teach or suggest a “catch-word having a respective option function allocated thereto” as required in the present claims. As discussed above, Overy clearly discloses the use programmable soft keys, wherein a calling function is specifically programmed to the key itself to recall a memory location from a list of calling options (col. 9, lines 2-7). Moreover, Overy fails to teach or suggest selecting a function without changing operating modes in the process, wherein, when a catch-word is selected by the user via the input device, a respective option function allocated to the catch-word is immediately implemented after the selected catch-word has been confirmed. The structure of Overy specifically required the use of different operating modes during the process of executing the soft key functions, and doesn’t use catchwords to identify the function.

Furthermore, Applicants submit that there is no teaching, suggestion or motivation for one of ordinary skill in the art to combine the Morgenthaler and Overy references in the manner suggested in the Office Action. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. When the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the examiner to explain why the combination of the teachings is proper. *Ex parte Skinner*, 2 USPQ2d 1788 (Bd. Pat. App. & Inter. 1986). (see MPEP 2142).

Further, the Federal Circuit has held that it is “impermissible to use the claimed invention as an instruction manual or ‘template’ to piece together the teachings of the prior art so that the claimed invention is rendered obvious.” *In re Fritch*, 23 U.S.P.Q.2d 1780, 1784 (Fed. Cir. 1992). “One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention” *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

Moreover, the Federal Circuit has held that “obvious to try” is not the proper standard under 35 U.S.C. §103. *Ex parte Goldgaber*, 41 U.S.P.Q.2d 1172, 1177 (Fed. Cir. 1996). “An-obvious-to-try situation exists when a general disclosure may pique the scientist curiosity, such

that further investigation might be done as a result of the disclosure, but the disclosure itself does not contain a sufficient teaching of how to obtain the desired result, or that the claim result would be obtained if certain directions were pursued.” *In re Eli Lilly and Co.*, 14 U.S.P.Q.2d 1741, 1743 (Fed. Cir. 1990).

Morgenthaler discloses a user interface for assisting a user in the operation of a telephone, where a software menu is provided with illumination keys to guide a user in pressing a proper sequence of keys to navigate through a menu or a selected function (col. 3, lines 49-67). As discussed above, Overy discloses a radio telephone operates in user selectable default modes to which the radio telephone returns under predetermined conditions wherein a specific key (14, 15) is assigned with an associated legend for indicating the prevailing function associated to the key. The Office Action fails to disclose how the different operating modes of Overy could be applied to the indexing menu of Morgenthaler (see col. 6, lines 33-60). Furthermore, as Morgenthaler *already provides a pre-determined sequence of menu-navigation via the selective illumination of individual keys*, there is no conceivable teaching, suggestion or motivation to turn to Overy to associate different operating modes with specific telephone numbers.

In light of the above-Applicant respectfully submits that independent claim 9 of the present application, as well as claims 6-8 which respectively depend therefrom, are both novel and non-obvious over the art of record. Accordingly, Applicant respectfully requests that a timely Notice of Allowance be issued in this case. If any additional fees are due in connection with this application as a whole, the office is hereby authorized to deduct said fees from Deposit Account No.: 02-1818. If such a deduction is made, please indicate the Attorney Docket Number (0112740-459) on the account statement.

Respectfully submitted,

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